

REMARKS

The Examiner is thanked for the careful examination of the application. However, in view of the following remarks, the Examiner is respectfully requested to reconsider and withdraw the rejections.

Double Patenting:

Three provisional double patenting rejections have been made. However, in view of the fact that the rejections are provisional and that the claims of any of the applications may later be changed, Applicant respectfully requests that the rejections be held in abeyance. Applicant reserves the right to challenge any of the rejections at a later time if necessary.

Art Rejections:

Claims 1 – 7, 9, and 12 – 19 have been rejected under 35 USC 103(a) as allegedly being unpatentable over USP 4,287,104, hereinafter *Francis*, in view of USP 3,839,141, hereinafter *McKinnon*. First, it is not clear how *McKinnon* factors into the rejection. Accordingly, *McKinnon* is not addressed herein. If the Examiner intended to rely on *McKinnon*, clarification is requested.

The relevant claims 1 – 19 recite various structures that have certain structural qualities or details. For example, claim 1 recites that the coating penetrates into the gypsum core, and claims 13 – 15 recite that the boards have a particular finish. It is noted that the claim features result not only from certain elements used in the construction, but also from the methods disclosed in the specification by which the claimed boards are constructed. Accordingly, although claims 1 – 19 are product claims, the products result from a combination of the materials used and the methods by which they are assembled. For example, one method of enabling the coating to penetrate into the gypsum core is to apply the coating when the board is wet. As another example, *Francis* teaches a specific viscosity of the joint compound (350 to about 750 Brabender units at 70F, column 6, lines 55 - 65), which is undoubtedly good for applying a joint compound, but is more than likely too thick to be used as a skim coat. Thus, in the arguments set forth

below, in some cases the method of construction is relevant, even though the claims define the resulting product.

The Examiner relies upon *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980) so as to shift the burden of proving differences between the prior art and the claimed invention to the Applicant. However, *In re Fitzgerald* is different than the present case. In *In re Fitzgerald*, there were minimal differences between the elements and production methods. See footnote 1, which states "Both fasteners possess the same utility, employ the same crystallizable polymer (nylon 11), and have an adherent plastic patch formed by melting and then cooling the polymer." In the present case, differences between the claimed features and the applied prior art can be determined from the information provided in both *Francis* and the specification of the present application. Clearly, a diluted form of joint compound applied to a wet board is going to result in a different structure and appearance than regular joint compound applied to a dry board.

For example, better adhesion of the facing sheet to the gypsum board and increased board strength, as measured by nail pull, result from the methods taught in the present application. See, in particular, paragraphs [0065] to [0067] of the present application. The coating improves nail pull values by up to 25%. This allows for the use of facing sheets of lower weight or quality, with attendant cost reductions. These improved properties may not be attained by coating the boards in an already erected wall and in fact by only filling the shallow valley formed by the edges (as it is the case in *Francis* et al.). These improved properties may only be attained by coating one side of the boards during the manufacturing process, which is reflected in the wording of present product claim 1.

Claims 1 – 7, 9, and 12 recite that a portion of the coating penetrates into the gypsum core. As is explained in the present specification, the depth of penetration of the coating is influenced by the relative moisture level and/or degree of set. And, if the moisture content is low, the coating may only penetrate into the paper facing sheet, i.e., and not into the core. See paragraph [0047] of the published application. Although the present invention is not limited to the preferred disclosed embodiments, one way of having the coating penetrate into the paper is to have the coating applied on a relatively wet board.

In contrast to the present application, *Francis* neither mentions nor suggests that the coating penetrates into the core. Furthermore, *Francis* teaches applying the coating to an assembled board that is presumably well set and dry. See column 2, lines 30 – 31. Accordingly, whether or not the same materials are used, as alleged by the Examiner, *Francis* does not teach that the coating penetrates into the core. In fact, according to paragraph [0047] of the present application, it is likely that the coating does not penetrate into the core. Accordingly, contrary to the assertions of the Examiner, there is no teaching or suggestion of the *Francis* coating penetrating into the core. There is no explanation as to how *McKinnon* is used in the rejection.

Accordingly, claims 1 – 7, 9 and 12 are clearly patentable over *Francis*.

Claim 13 recites a coating disposed on at least a portion of the facing sheet such that the facing sheet has a level 5 finish. A level 5 finish is defined in the specification. The specification furthermore teaches a certain combinations of materials that form the coating, various ways of applying the coating, such as on a wet board, and forming a skim coat with the coating. None of those features are taught or even suggested by *Francis*. Accordingly, it is not sufficient to say that *Francis* may use the same materials. Even if the materials were the same, *Francis* does not teach the way of applying them that is taught in the present specification in order to arrive at the claimed product that includes a level 5 finish. However, the present invention is not limited to the specific embodiments disclosed in the specification.

Accordingly, in view of the differences between the methods taught by *Francis* and the resulting boards of claims 13 – 14, Applicant submits that claims 13 – 14 are patentable.

Claim 15 recites a coating disposed on at least a portion of the facing sheet such that the facing sheet has a level 4 finish. A level 4 finish is defined in the specification. The specification furthermore teaches a certain combinations of materials that form the coating, various ways of applying the coating, such as on a wet board, and forming a skim coat with the coating. None of those features are taught or even suggested by *Francis*. Accordingly, it is not sufficient to say that *Francis* may use the same materials. Even if the materials were the same, *Francis* does not teach the way of applying them that is taught in the present specification in

order to arrive at the claimed product that includes a level 4 finish. However, the present invention is not limited to the specific embodiments disclosed in the specification.

Accordingly, in view of the differences between the methods taught by *Francis* and the resulting boards of claim 15, Applicant submits that claim 15 is patentable.

Claim 16 recites that a kit includes a quantity of joint compound and a plurality of gypsum boards having a coating thereon, and that the coating is a diluted form of the joint compound. In contrast to claim 16, *Francis* does not teach that there is both a coating on the board, as well as the joint compound. Accordingly, claim 16, and dependent claims 17 - 19 are patentable over *Francis*.

Claims 8, 10, and 11 have been rejected under 35 USC 103(a) as being unpatentable over *Francis* in view of USP 6,105,325, hereinafter *Zuber*. However, the portions of *Zuber* relied upon by the Examiner do not overcome the deficiencies of *Francis*.

New claims 28 – 31 further recite that the coating is disposed on an entirety of the facing sheet. This is clearly different from *Francis*, wherein the joint compound is only applied to the shallow valley at the edges of the board. Accordingly, new claims 28 – 31 are also patentable.

In view of the foregoing arguments, the Examiner is respectfully requested to reconsider and withdraw the rejections.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

Respectfully submitted,

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